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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,519	12/14/2001	Betty Wu	19662-029001	3927
26161	7590	01/24/2006	EXAMINER	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			SINES, BRIAN J	
			ART UNIT	PAPER NUMBER
			1743	
DATE MAILED: 01/24/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/014,519

Applicant(s)

WU ET AL.

Examiner

Brian J. Sines

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,9,12-14,16-19,21-23,25-30,32,33 and 35-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,9,12-14,16-19,21-23,25-30,32,33 and 35-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Election/Restrictions

This application contains claim 38 drawn to a nonelected invention. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

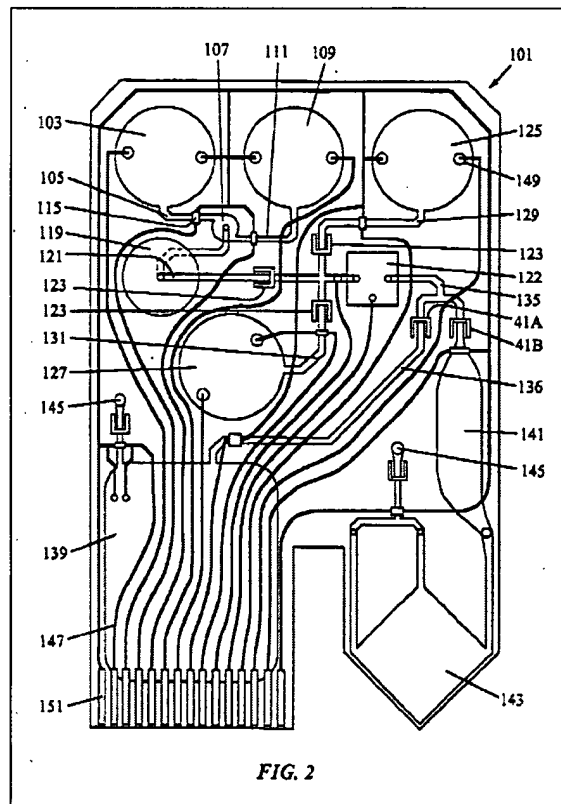
The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 – 4, 9, 12 – 14, 16 – 19, 21 – 23, 25 – 30, 32, 33, 35 – 37 & 39 – 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pourahmadi et al. (U.S. Pat. Pub. No. US 2002/0055167 A1) (hereinafter “Pourahmadi”) in view of Handique et al. (U.S. Pat. No. 6,130,098 A) (hereinafter “Handique”).

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Regarding claims 1, 9, 12, 13, 16, 23, 26 & 39, Pourahmadi teaches an apparatus (cartridge 101) comprising: a sample port (103); a channel (105); and a lysing zone (lysing chamber 119) (see paragraph 0048; figure 2).



Pourahmadi does not specifically teach the further incorporation of a gas actuator and an associated vent structure to facilitate sample fluid flow within the disclosed apparatus.

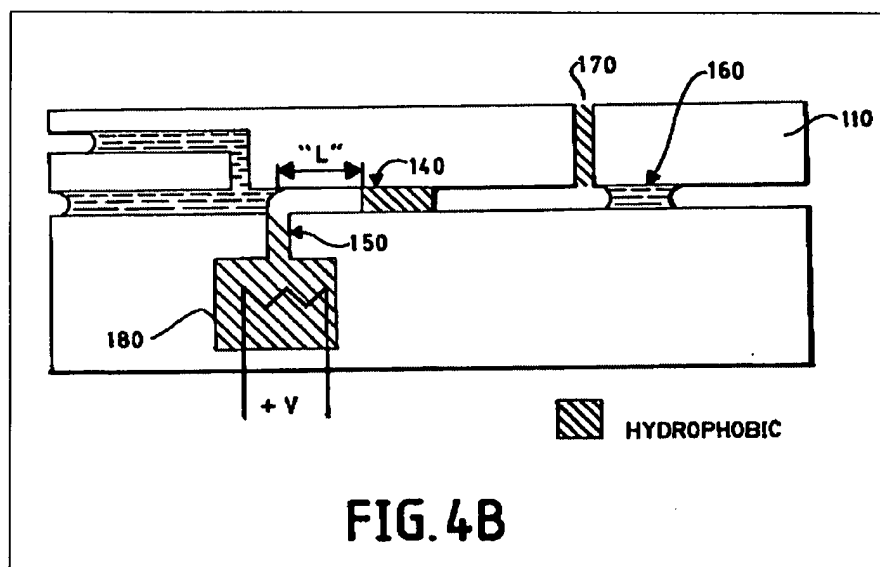
Pourahmadi does teach that a fluid sample may be introduced into the cartridge by a variety of means, manual or automated (see paragraph 0078). Pourahmadi teaches that for automated sample introduction, additional cartridge design features are employed and, in many cases, impart specimen accession functionality directly into the cartridge (see paragraph 0080).

Pourahmadi does further teach that a fluid motive source comprising a pneumatic pressure

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source can be internally incorporated within the cartridge apparatus for facilitating sample fluid transport (see paragraph 0067).

Handique teaches a thermopneumatic apparatus for facilitating fluid transport in microfluidic devices (see col. 13, line 60 – col. 15, line 40; figures 3A, 3B, 4A & 4B). As shown in figure 4B, the system taught by Handique comprises a thermopneumatic actuating system denoted by 180, a hydrophobic gas vent (170), and an outlet, which is located to the right of the sample (160) and at the end of the channel containing the sample, from which the sample is transferred for further processing, such as to a lysing chamber for cell lysing, when integrated within an analytical microfluidic system.



Hence, as evidenced by Handique, a person of ordinary skill in the art would accordingly have had a reasonable expectation for success in incorporating such a thermopneumatic fluid transport system with a microfluidic apparatus. The Courts have held that the prior art can be modified or combined to reject claims as *prima facie* obvious as long as there is a reasonable expectation of success. See *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir.

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1986) (see MPEP § 2143.02). Therefore, it would have been obvious to a person of ordinary skill in the art to incorporate such a thermopneumatic fluid transport system with a microfluidic apparatus for facilitating effective sample fluid transport.

Furthermore, regarding claims 16, 21, 25 & 39, Pourahmadi in view of Handique teaches the additional incorporation of a positioning element (e.g., a hydrophobic region 140) and a thermopneumatic actuator downstream of the lysing chamber 119 for facilitating sample fluid flow within the apparatus for further processing (see figure 2). Pourahmadi teaches that the lysed sample proceeds from the lysing chamber 119 down channel 121 and is forced to flow through a capture component 122 (see paragraph 0070; figure 2). Hence, a person of ordinary skill in the art would have recognized the suitability of incorporating a fluid motive source, such as the thermopneumatic system of Handique, within the apparatus of Pourahmadi to facilitate effective sample fluid transport (see MPEP § 2144.07). As discussed above, as evidenced by Handique, a person of ordinary skill in the art would accordingly have had a reasonable expectation for success in incorporating such a thermopneumatic fluid transport system with a microfluidic apparatus (see MPEP § 2143.02). Therefore, it would have been obvious to a person of ordinary skill in the art to incorporate a secondary thermopneumatic fluid transport system with a microfluidic apparatus as claimed for facilitating effective sample fluid transport.

Regarding claims 2, 4, 17 & 19, these claim recitations are considered process or intended use limitations.

Regarding claims 3, 4, 18 & 19, Pourahmadi teaches the incorporation of a cell lysis mechanism utilizing an electrical field to facilitate cell lysis and extraction (see paragraph 0112).

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Regarding claims 14 & 39, Handique suggests the incorporation of valves, which are well known in the art, with the hydrophobic vents (70 & 170) for opening and closing the vents for facilitating sample fluid transport (see col. 14, lines 51 – 57; figures 3A, 3B, 4A & 4B) (see MPEP 2144.03). In addition, Pourahmadi teaches the incorporation of various valves within the disclosed microfluidic apparatus (see, e.g., paragraph 0052). Therefore, it would have been obvious to a person of ordinary skill in the art to provide a plurality of valves within the apparatus as claimed in order to facilitate effective sample fluid flow within apparatus.

Regarding claim 22, Handique teaches that the various features of the microfluidic apparatus are microfabricated and integrated within silicon and glass substrates (see col. 3, line 46 – col. 4, line 10). Pourahmadi also teaches that the disclosed apparatus is microfabricated utilizing glass or silicon structural members as well (see paragraphs 0097 & 0098). Hence, a person of ordinary skill in the art would accordingly have had a reasonable expectation for success in microfabricating an integrated microfluidic apparatus as claimed (see MPEP § 2143.02). Therefore, it would have been obvious to a person of ordinary skill in the art to microfabricate an integrated microfluidic apparatus as claimed.

Regarding method claims 27 – 30, 32, 33, 35 – 37 & 40 – 44, as discussed above, Pourahmadi in view of Handique teaches all of the positively recited structure of the apparatus provided in the claimed method, which merely recites the conventional operation of that apparatus. Therefore, it would have been obvious to a person of ordinary skill in the art to perform the method recited in the instant claims upon the apparatus of Pourahmadi and Handique, as such is the intended operation of that apparatus.

Response to Arguments

1. Regarding the rejection of claims 1 – 4, 9, 12 – 14, 16 – 19, 21 – 23, 25, 26, 39 & 40 – 44 under 35 U.S.C. 112, first paragraph, applicant's arguments filed 11/3/2005 have been fully considered and are persuasive. This rejection has been withdrawn.
2. Regarding the rejection of claim 28 under 35 U.S.C. 112, second paragraph, applicant's arguments filed 11/3/2005 have been fully considered and are persuasive. This rejection has been withdrawn.
3. Regarding the rejection of claims 1 – 4, 9, 12 – 14, 16 – 19, 21 – 23, 25 – 30, 32, 33, 35 – 37 & 39 – 44 under 35 U.S.C. 103(a) as being unpatentable over Pourahmadi in view of Handique, applicant's arguments filed 11/3/2005 have been fully considered but they are not persuasive. In response to applicant's argument that the disclosed teachings of each of the references are essentially incompatible with respect to sample volume processing, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Pourahmadi does teach that the disclosed apparatus is capable of processing sample volumes of 10 μ L or less (see paragraphs 0077 and 0163). Pourahmadi does teach that current microfluidic devices are capable of processing large, i.e., microliter, and small sample volumes, i.e., picoliter and nanoliter fluid volumes (see paragraphs 0007 – 0010; figure 1). Pourahmadi does indicate that the disclosed device is capable of performing immunoassays that, as shown in figure 1, use approximately nanoliter sample

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volumes and less (see paragraph 0087). Handique also teaches the use of sample volumes of between approximately 0.01 and 100 nanoliters (see col. 7, lines 53 – 63). Thus, both microfluidic devices can process similar sample volumes. Furthermore, both disclosed microfluidic devices can be made using the same fabrication techniques, e.g., photolithography (see Handique, col. 4, lines 7 – 10; Pourahmadi, paragraph 0098). The Court has recognized that an artisan is presumed to have skill, rather than lack of skill. See *In re Sovish*, 226 USPQ 771 (Fed. Cir. 1985). Thus, a person of ordinary skill in the art would accordingly have had a reasonable expectation for success in incorporating such a thermopneumatic fluid transport system, as taught by Handique, with the microfluidic apparatus of Pourahmadi. The strongest rationale for combining references is a recognition, expressly or impliedly in the prior art or drawn from a convincing line of reasoning based on established scientific principles or legal precedent, that some advantage, or expected beneficial result would have been produced by their combination. See *In re Sernaker*, 702 F.2d 989, 994 – 995, 217 USPQ 1, 5, 6 (Fed. Cir. 1983) (see MPEP § 2144). In addition, the rationale to support an obviousness rejection under 35 U.S.C. 103 may rely on logic and sound scientific principle (see MPEP § 2144.02). Handique does teach that the disclosed fluid transport mechanism significantly improves fluid sample processing overcoming liquid handling inefficiencies within conventional analytical microfluidic devices (see col. 3, lines 33 – 64). Therefore, it would have been obvious to a person of ordinary skill in the art to incorporate such a thermopneumatic fluid transport system with the disclosed microfluidic apparatus as claimed for facilitating effective sample fluid transport and processing.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Sines, whose telephone number is (571) 272-1263. The examiner can normally be reached on Monday - Friday (11 AM - 8 PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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